

## **REMARKS**

Claims 1-16 are pending.

Claims 5-13 are withdrawn.

Claims 1-4 and 14-16 are rejected.

By this Amendment, claims 1, 3 and 14-15 are amended. Accordingly, claims 1-16 are now presented for consideration.

No new matter is being presented by the claim amendments, accordingly, entry and consideration of same are submitted to be proper and, are respectfully requested.

## **AMENDMENT TO TITLE**

In the Office Action at page 2, item 4, a new title of the invention is required.

The title of the invention is amended in accordance with the Examiner's suggestion. Accordingly, it is submitted that the Examiner's objection is overcome.

Reconsideration is respectfully requested.

## **CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)**

In the Office Action at page 3, item 5, claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Scuricini (US Patent No. 4,096,988).

Reconsideration is respectfully requested.

### **Claim 1**

Claim 1 is directed to a disc balancing device, and recites "a laser cutter moving to track and to laser-cut a side portion of the disc corresponding to the eccentric position, while the disc is not rotating."

### **Scuricini Reference**

Scuricini discloses "allowing pre-established amounts of material to be removed from the rotating body through melting or sublimation, or to be added to it, in predetermined positions, the

rotating body being maintained within its own frame and **at a running speed which may be close to that of the normal operating condition**" (emphasis added). (See Scuricini at column 3 lines 22-28). That is, contrary to the present invention recited in claim 1, Scuricini discloses a method in which material is added or removed from the rotating body, while the rotating body rotates and, in particular, Scuricini is silent regarding "the laser cutter moving to track and to laser-cut a side portion of the disc... while the disc is not rotating" (as recited in claim 1).

Accordingly, it is submitted that claim 1 patentably distinguishes over the cited art for the above-mentioned reasons, and is submitted to be allowable.

Claim 14, which includes patentably distinguishing features similar to those of claim 1, is also submitted to be allowable.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Office Action at page 4, item 7, claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scuricini in view of Asada (U.S. Patent No. 5,762,663).

In the Office Action at pages 4-5, item 8, claims 4, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scuricini in view of Duston et al. (U.S. Patent No. 3,538,298).

Reconsideration is respectfully requested.

Claims 2-4 and 15-16 are submitted to be allowable over Scuricini for at least their respective dependencies on claims 1 and 14.

It is submitted that the additional references of Asada and Duston et al. do not overcome the deficiencies of Scuricini because Asada and Duston et al. do not disclose or suggest "a laser cutter moving to track and to laser-cut a side portion of the disc corresponding to the eccentric position, while the disc is not rotating." Asada is directed to a wet dust collecting apparatus, and is completely silent regarding anything related to balancing of a rotating body. Further, Duston et al., like that of Scuricini, is a method which operates on rotating objects. More particularly, for example, FIG. 2 of Duston et al. illustrates an apparatus arrangement to remove material from a rotating object. (See Duston et al. at column 3, lines 55-56.) That is, contrary to the invention recited in claim 1, in the Duston et al. method, lasers 1 and 14 remove

material while the rotor 5 rotates.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is respectfully solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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